

REMARKS

Applicant acknowledges receipt of the initialed Form PTO/SB/08 forming part of the IDS filed with the application on October 31, 2005.

Examiner Karacsony issues the following three final statutory prior art rejections:

- (1) Claims 12 and 18-22 are rejected under 35 U.S.C. § 102(b) as being anticipated by Koyama '988;
- (2) Claims 13-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Koyama in view of Bokhari '634; and
- (3) Claim 14 is (sic, claims 14-17 are) rejected under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Koyama in view of DeSantis '395.

Even though Examiner Karacsony refers to "the new ground(s) of rejection", these statutory rejections appear to be identical to the previous statutory rejections but the Examiner's arguments in support of the rejections have been modified, especially "Interpretation 2" referring to the alleged readability of claims 12 and 18-22 on Koyama's disclosure.

In any event, Applicant respectfully **traverses** all three of these rejections, insofar as they may be applied to the amended claims 12-22, especially the currently amended independent parent claim 12.

Rejection (1) requires that Koyama disclose, either expressly or inherently, each limitation of the rejected claims 12 and 18-22, or in other words, that each of claims 12 and 18-22 be **readable** on Koyama's disclosure. Applicant respectfully submits that clearly such is **not** the case, insofar as this rejection may be applied to the amended claim 12. More specifically,

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claim 12 now requires that said "**electrically conductive part has a portion thereof extending at least substantially to the level of the bottom surface of the printed circuit board**".

Applicant respectfully submits that this added limitation is not taught or even suggested by Koyama.

Thus, Applicant must respectfully disagree with the Examiner's several statements that, "Koyama teaches all of the limitations of claim 12...", for the following reasons.

In detail, Koyama discloses a wristwatch comprising an antenna device which comprises an antenna element and connected to a ground plane via a feeding line. The ground plane is mounted on the top surface of a printed circuit board. The ground plane is connected to the back cover. The back cover has a generally flat shape which is separated from the PCB 2 by an insulating plastic member 5. The contact between the ground plane and the antenna is achieved, then, through the battery 6 (column 10, lines 42-45).

Such a mounting structure is complicated and costly, and requires not only the provision of an insulating mounting ring 5 but also the presence of a battery at a certain place and in contact with the back cover.

Furthermore, according to Koyama, the conductive part of the case is apparently limited to the back cover. Therefore, since the middle of the case is not electrically conductive, the enlargement of the ground plane is absolutely not located in "the plane containing the ground plane of the antenna", **contrary** to the requirements of claim 12.

Consequently, Koyama does not disclose or even suggest the claim 12 limitation that "said electrically conductive part has a portion thereof extending at least substantially to the level

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of the bottom surface of the printed circuit board...to enlarge the ground plane", and to allow the PCB to bear directly on the "electrically conductive part" of the case, thereby providing a more simple and efficient antenna mounting structure.

Therefore, since the parent claim 12 clearly is **not readable** on Koyama, Applicant respectfully submits that Koyama is **incapable of anticipating** parent claim 12 (and its dependent claims 18-22), whereby Applicant respectfully requests the Examiner to reconsider and withdraw rejection (1) above.

With respect to rejection (2) and the dependent claims 13-17, Applicant has explained above the deficiencies in Koyama's disclosure relative to the limitations of parent claim 12. Since claims 13-17 inherit the limitations of their parent claim 12, and in view of the above described deficiencies in Koyama's disclosure, Applicant respectfully submits that Koyama does not disclose, or even suggest, all of the limitations of claims 14-17, whereby Koyama is **incapable of rendering obvious** the subject matter of claims 13-17.

Furthermore, since Koyama does **not** teach "all of the limitations of claim 12" (as asserted by the Examiner), it is clear that, even if for some reason Koyama were modified to use "the microstrip antenna of Bokhari as the antenna element of Koyama" (as proposed by the Examiner), there would not be produced the subject matter of any of claims 13-17, or subject matter which would have rendered these claims unpatentable (obvious).

Therefore, Applicant also respectfully requests the Examiner to reconsider and withdraw rejection (2) above.

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The above reasoning also applies to rejection (3) above. That is, claims 14-17 inherit the limitations of their parent claim which, as already explained above, contains limitations which are neither taught nor even suggested by Koyama.

It is clear that DeSantis '395 does not provide the deficiencies of Koyama, and the Examiner does not assert otherwise.

Moreover, even assuming, *arguendo*, the correctness of the Examiner's summary of the disclosure of DeSantis '395, it is clear that, even if for some reason a person were to combine "the conductive elastomer" of DeSantis with the invention of Koyama", there would not be produced the subject matter of any of claims 14-17, or subject matter that would have rendered these claims obvious.

Therefore, Applicant also respectfully requests the Examiner to reconsider and withdraw rejection (3) above because, as explained above, the Koyama/DeSantis combination does not disclose or even suggest all of the limitations of each of claims 14-17.

In summary, then, and for the reasons presented above, Applicant respectfully requests the Examiner to reconsider and withdraw rejections (1), (2) and (3) above insofar as these rejections may be applied to the amended claims 12-22, and to find the application to be in condition for allowance with all of **claims 12-22**; however, if for any reason the Examiner feels that the application is not now in condition for allowance, he is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application.

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Applicant files concurrently herewith a Petition (with fee) for an Extension of Time of one month. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

Respectfully submitted,

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